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10/732,850	12/10/2003	Marvin L. Green	IN-5587	8857
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BASF CORPORATION Patent Department 1609 BIDDLE AVENUE MAIN BUILDING WYANDOTTE, MI 48192			EXAMINER NILAND, PATRICK DENNIS	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/732,850
Filing Date: December 10, 2003
Appellant(s): GREEN ET AL.

Anna Budde
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/18/07 appealing from the Office action mailed 8/28/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/0155278	BOISSEAU ET AL.	10-2002
5872195	GREEN ET AL.	2-1999
5756213	OHRBOM ET AL.	5-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

A. Claims 1-3 and 7-15 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. Application Publication No. 2002/0155278 Boisseau et al..

Boisseau discloses coating compositions and coating methods falling within the scope of the instant claims at the abstract; sections [0019], [0022], [0026] which falls within the scope of the instant claims 12 and 14, [0038]-[0043] which falls within the scope of the instant claims 9-10, [0048] of which the oligomeric film formers fall within the scope of the instant claims as they are not polymeric since they are oligomeric and they can be further polymerized and are thus monomers, [0050] which falls within the scope of the instant claim 2, [0098], [0099], [0105] which falls within the scope of the instant claim 15; and the remainder of the document.

The appellant argues that the patentee requires the film former to be oligomeric or polymeric, not monomeric. The instant claims and the enabling specification do not exclude oligomers, which are not polymers as is clear from the appellant's arguments relating to the prior 112 rejection, by recitation of "non-polymeric". The oligomers of the reference react further to give higher molecular weight polymer when cured and are therefore necessarily

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“macromonomers” as the term is well understood in the art and are thus “monomeric”. This rejection should therefore be affirmed.

B. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. Application Publication No. 2002/0155278 Boisseau et al. in view of US Pat. No. 5872195 Green et al. and US Pat. No. 5756213 Ohrbom et al..

Boisseau et al. discloses coating compositions and coating methods falling within the scope of the instant claims at the abstract; sections [0019], [0022], [0026] which falls within the scope of the instant claims 12 and 14, [0038]-[0043] which falls within the scope of the instant claims 9-10, [0048] of which the oligomeric film formers fall within the scope of the instant claims as they are not polymeric since they are oligomeric and they can be further polymerized and are thus monomers, [0050] which falls within the scope of the instant claim 2, [0098], [0099], [0105 which falls within the scope of the instant claim 15; and the remainder of the document.

Boisseau et al. does not disclose the instantly claimed monomers of claims 4-6.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed monomers of claims 4-6 as the film forming agent of Boisseau et al. because Boisseau et al. encompasses such film formers at sections [0048] through [0098] and Ohrbom, columns 2 through 8, which falls within the scope of the instant claims 5-6, and the ordinary skilled artisan would have expected the benefits of these film formers as taught by Green (abstract) of which compound c falls within the scope of the instant claim 4, combined with the benefits of the urea compounds of Boisseau et al..

The appellant argues that the patentees require the film formers to be oligomeric or polymeric, not monomeric. The instant claims and the enabling specification do not exclude oligomers, which are not polymers as is clear from the appellant's arguments relating to the prior 112 rejection, by recitation of "non-polymeric". The oligomers of the references react further to give higher molecular weight polymer when cured and are therefore necessarily "macromonomers" prior to curing as the term is well understood in the art and are thus "monomeric". This rejection should therefore be maintained.

(10) Response to Argument

A. In response to the appellant's arguments regarding the anticipation rejection of paragraph 9A. above:

Page 10, lines 4-5 of the appellant's specification states "Higher oligomer products are also possible, but not preferred." clearly indicating that the instantly claimed inventions encompass the "oligomers" of the prior art cited above. This appears to rebut the appellant's argument that their "coating composition is non-polymeric, unlike the polymeric and oligomeric coatings described in Appellant's background, page 2, paragraphs [0003] and [0004] and exemplified in the Boisseau publication."

In response to "112" rejections made in prior prosecution of this application, the appellant argued "Examples of monomeric materials are presented in the specification in paragraphs [0013] to [0027] and the U.S. patent references cited therein." It is again noted that paragraph

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[0020], page 10, lines 4-5 of the instant specification includes “oligomers” as the instantly claimed “monomers” which is contrary to the appellant’s arguments in this regard. Thus, the examiner’s position is that the “oligomers” of Boisseau et al. fall within the scope of the instant claim language, including “non-polymeric” and “monomeric material” based on the appellant’s own definition of their invention at page 10, lines 4-5 of the instant specification. It is not seen that the appellant’s cited definition of “oligomer” overcomes the instant specification recitation that “oligomers” are included as part of the instantly claimed invention. The appellant’s cited definition of “monomer” also does not define over their specification’s inclusion of oligomers as falling within the scope of the monomers being described at page 10, lines 4-5. The “oligomers” of Boisseau et al. are reacted with the reference’s crosslinking agents to become “one or more constitutional units of” the crosslinked larger polymer molecule that results from the crosslinking reaction of Boisseau et al. and thus the “oligomers” of Boisseau et al. literally meet the appellant’s cited definition of “monomer” not to mention the appellant’s specification includes oligomers as falling within the scope of the claimed invention at page 10, lines 4-5. Thus, the examiner’s reference to “macromonomers” and his assertion that the oligomers of Boisseau et al. fall within the scope of the instant claims are clearly not contrary to the appellant’s specification and the IUPAC definitions of these materials.

Furthermore, sections [0044]-[0046] et seq. of the instant specification include polymeric substances among the instantly claimed “monomeric materials” and “non-polymeric coating compositions” as being within the scope of the instantly claimed invention, since this compound is based on a “polyester”. In fact, many of the disclosed “monomeric material having a plurality of active hydrogen groups” are also oligomeric or polymeric. Therefore, the appellant’s

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disclosure clearly includes Boisseau et al.'s oligomers within the scope of the instantly claimed invention.

The above anticipation rejection should therefore be affirmed.

B. In response to the appellant's arguments regarding the obviousness rejection of paragraph

9B. above:

The above arguments regarding the “oligomeric” active hydrogen containing compounds of Boisseau et al. falling within the scope of the instantly claimed “monomeric materials” and “non-polymeric” of the instant claims is again repeated and applied to the secondary references in view of the appellant’s disclosure which explicitly includes “oligomers” and uses “polymers” in its examples.

Appellant’s belief that the array of cited compounds of Ohrbom do not include lactone or hydroxyl carboxylic acid is not persuasive regarding claim 4 which does not require these compounds and ignores the relevant sections of the cited parts of the Ohrbom et al. patent that does have these compounds such as column 6, lines 47 et seq. and column 7, lines 31 et seq.

The appropriate rationale and motivation to combine the references is given above, particularly since Boisseau et al. broadly encompasses such compounds. There is no unexpected result for the components of claims 4-6. These compounds of Ohrbom and Green will have the same functional groups as those of Boisseau et al. and are therefore expected to have the resistance to sag. No evidence to the contrary is seen.

For these reasons, this rejection should be maintained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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